



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/933,951	09/19/97	TALTON	D 341/4

KENYON AND KENYON  
WILLIAM K WELLS JR  
1025 CONNECTICUT AVENUE  
SUITE 600  
WASHINGTON DC 20036

LM12/0204

EXAMINER

SAINT SURIN, J

ART UNIT

PAPER NUMBER

2747

# 5

DATE MAILED:

02/04/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/933,951**

Applicant(s)  
**David Talton**

Examiner  
**Jacques M. Saint-Surin**

Group Art Unit  
**2747**



☒ Responsive to communication(s) filed on Sep 19, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-31 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Applicant has requested a title report to be provided for the reissue application. However, "the requirement for the assignee to consent to filing a reissue no longer includes a requirement for applicant to order a title report with the filing of the reissue application. Rather, the assignee entity is established by a statement on behalf of all the assignees under 37 CFR 1.172(a) and 37 CFR 3.73(b). See MPEP 1410.01.

#### ***Reissue Applications***

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The declaration does not specifically identify an error. The declaration states only that applicant is aware that he claimed less than he had a right to claim. See M.P.E.P. 1414 (II).

3. Claims 1-31 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3 Applicant is required to file a reissue oath or declaration which, in addition to complying with 37 CFR 1.63, must comply with 37 CFR 1.175. The oath or declaration or filing fee may be submitted after

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4. The offer to surrender has been made. However, applicant is reminded that the original patent or an oath/declaration as to its unavailability must be submitted before allowance. See: 37 C.F.R. 1.178.
5. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.
6. Claims 1-31 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

***Claim Rejections - 35 USC § 112***

7. Claims 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 29-31 recite steps of (g) and (h) which differ from steps (g) and (h) of claim 28. The redundancy of letters (g) and (h) for different steps of different claims is not proper and makes the claims indefinite. Applicant may overcome the rejection by deleting (g) and (h) in the corresponding claims and rewrite the steps as follows: claim 29

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comprises the steps of (I) and (j); claim 30 comprises step (k) and claim 31 comprises step (l).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 26-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Winebaum et al. (US Patent 4,941,172).

Regarding claim 26, Winebaum et al. ('172) discloses an electronic card sized direct dialing device that comprises:

a case of size and shape (compact credit "card" type housing, Figs. 3 and 10) corresponding to the size and shape of a credit card to be inserted into a computer (microprocessor 32);

an output unit (speaker 24) disposed in the case and outputting a first signal identifiable by a telephone network as a telephone number (DTMF generator 38 decodes a preprogrammed telephone number under control of program control software and generates a sequence of corresponding DTMF tones);

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an input unit disposed in the case and receiving an available access signal and a request signal from the telephone network (when switch 26 is actuated, (Fig. 4, block 100) microprocessor 32 reads data representing a telephone number stored in ROM 34, (for example, 1-800-123-4567) at block 104 and applies the first value in the string to DTMF generator 38 (block 106) and DTMF generator 38 produces the DTMF tone pair corresponding to the first value for a time period controlled by microprocessor 32 (block 108) and subsequently causes to produce the tone pair) see: Fig. 4, col. 6, lines 60-68, col. 7, lines 1-6;

a bus disposed in the case (connection between the microprocessor and ROM 34 and RAM 36, fig. 3);

a processor (microprocessor 32) disposed in the case and coupled to the output unit and the input unit via the bus;

said input (speaker 24) receiving access data and storing the access data in memory (ROM 34) ;

said processor retrieving the access data from memory (microprocessor 32 reads data representing a telephone number stored in ROM 34, for example 1-800-123-4567 at block 104) and sending them to the telephone network in response to detecting the available access signal (and applies the first value in the string to DTMF generator 38 (block 106) and DTMF generator 38 produces the DTMF tone pair corresponding to the

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first value for a time period controlled by microprocessor 32 (block 108) and subsequently causes to produce the tone pair) see: Fig. 4, col. 6, lines 60-68, col. 7, lines 1-6.

Regarding claim 27, as discussed above, it is rejected for the reasons set forth for claim 26. Furthermore, Winebaum et al. teaches that the duration of the tone pair produced by DTMF generator 38 should be sufficient to enable the telephone company switch tone decoders to properly detect and decode the tone pair (see: col. 7, lines 6-10).

Regarding claim 28, Winebaum teaches the transmission of audible signals from the dialer (chip 20) to a telephone handset (telephone handset 46, 48, Fig. 3) to access the telephone network and receiving audible signals (speaker 24) from the telephone handset with the dialer (chip 20, Fig. 3).

Regarding claim 29, Winebaum teaches microprocessor 32 which reads data representing a telephone number stored in ROM 34, for example 1-800-123-4567 at block 104) and storing at least temporarily the access data in memory (RAM 36, Fig. 3) of the dialer (chip 20).

Regarding claim 30, Winebaum et al. discloses in Fig. 9 a specific telephone number is provided by a phone company (block 120) and programmed into microprocessor chip (block 122)

Regarding claim 31, Winebaum et al teaches decision block (110) at which tones corresponding to the entire predetermined telephone number will have been produced by

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speaker 24 and acoustically coupled to the telephone line via handset microphone 48 (see: col. 7, lines 21-29.

***Allowable Subject Matter***

10. Claims 1-25 are allowable over the prior art of record.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bazemore et al. (US Patent 5,377,263) disclose a telephone dialer card.

Feldman (US Patent 5,343,519) discloses an autodialer with pin feature.

McGuire (US Patent 5,455,857) discloses an automatic telephone calling card.

Sonoyama et al. (US Patent 5,539,819) disclose a credit card which generates a DTMF tone.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques M. Saint-Surin whose telephone number is (703) 305-4760. The examiner can normally be reached on Mondays through Thursdays from 8:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen, can be reached on (703) 305-4386. The fax phone number for this Group is (703) 308-5403.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Any response to this action should be mailed to:**

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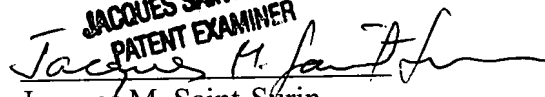
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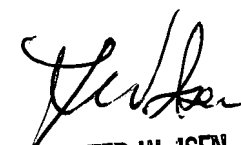
(703) 308-5403, (for formal communications intended for entry)

**Or:**

(703) 305-3900 [1] (for informal or draft communications, please label "PROPOSED" or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

**JACQUES SAINT-SURIN**  
**PATENT EXAMINER**  
  
Jacques M. Saint-Surin  
January 30, 1999

  
**FORESTER W. ISEN**  
**PRIMARY EXAMINER**  
**ART UNIT 2847**